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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: )  
 )  
Alain BETHUNE et al. ) Group Art Unit: 1734  
 )  
Application No.: 09/506,795 )  
 )  
Filed: February 18, 2000 ) Examiner: G. Koch III  
 )  
For: MATERIAL SUPPLY STRIP, SYSTEM, )  
AND METHOD OF APPLYING PIECES )  
OF MATERIAL TO OBJECTS )

**Mail Stop Appeal Brief--Patents**

Commissioner for Patents  
P.O. Box 1450  
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Sir:

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

This is an appeal to the Board of Patent Appeals and Interferences ("the Board") from the Office Action dated September 22, 2004 ("September 22, 2004, Office Action"), rejecting claims 1-6, 8-10, 12, 14, 16, 20-26, 28-35, 73, and 76, in the above-referenced patent application. Pursuant to 37 C.F.R. § 41.37, Appellants submit one copy of this Appeal Brief, accompanied by payment of the fee (\$500.00) set forth in 37 C.F.R. § 41.20(b)(2).

A Notice of Appeal was filed on December 21, 2004, and this Appeal Brief is being timely filed within two months from the filing date of the Notice of Appeal. (February 21, 2005, was a Government holiday.)

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**Real Party in Interest**

The real party in interest is L'Oréal S.A., the assignee of the entire right, title, and interest in the application, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 010899, Frame 0155, on July 5, 2000.

**II. Related Appeals and Interferences**

Appellants, Appellants' legal representatives, and assignee are aware of no other appeals, interferences, or judicial proceedings that may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

### III. Status of Claims

Claims 1-26, 28-35, 72, 73, and 76 are pending in this application. Claims 1-6, 8-10, 12, 14, 16, 20-35<sup>1</sup>, 73, and 76, as set forth in the Claims Appendix, have been rejected in the Office Action dated September 22, 2004, and the rejections applied to those claims are at issue in this appeal.

Claims 7, 11, 13, 15, 17-19, and 72 were withdrawn from consideration in view of a species-election requirement. Accordingly, those claims are not set forth in the Claims Appendix.

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<sup>1</sup> Claim 27 was incorrectly listed as "rejected" on the Office Action Summary page of the Office Action dated September 22, 2004. That claim was previously cancelled in the Amendment submitted on September 26, 2002.

IV. **Status of Amendments**

All amendments have been entered and no amendments under 37 C.F.R.

§ 1.116 have been filed subsequent to the rejections set forth in the Office Action dated September 22, 2004.

## **V. Summary of Claimed Subject Matter**

### **A. Claims 1 and 76**

The subject matter set forth in claims 1 and 76 relates to methods of applying pieces of material to objects. The methods include providing at least one applicator device capable of applying material from a supply strip to objects. The supply strip initially includes a backing with first and second opposing surfaces and pieces of material removably arranged on the first and second surfaces. Optionally, the pieces of material and the backing may be formed of substantially the same material. (See, e.g., page 4, lines 2-3, 14-16; page 15, lines 13-15.) The size of the pieces of material on the first surface may differ from the size of the pieces of material on the second surface. (Page 7, lines 6-7; page 14, lines 9-11.) Additionally, the pieces of material on the first surface may be centered with respect to corresponding pieces of material on the second surface. (See, e.g., page 11, lines 2-9, as amended on June 4, 2003.) The method further includes applying one or more pieces of material from the first and second surfaces of the backing to at least one object with the at least one applicator device. (Page 4, lines 16-20.)

Figs. 1 and 2 show an exemplary embodiment of the invention, including an application system 100 having an applicator device 102 and a roll of supply strip 4. The roll of supply strip 4 includes pieces of material 7, 6 (e.g., labels) on first and second surfaces 104, 106 of a backing 5. The pieces of material 7, 6 are applied to objects 8. (Page 13, lines 6-9, 18-19; page 14, lines 5-7.) The pieces of material 7, 6 (e.g., labels) are removably adhered to first and second surfaces 104, 106 of the backing 5. (Page 14, lines 5-7.) In the embodiments of Figs. 1 and 2, the pieces of material may have many different configurations. For example, the pieces of material 7 on the first surface



104 may be different than the pieces of material 6 on the second surface 106. (Page 7, lines 6-7.) In one embodiment, the pieces of material 7 could have a different size than the pieces of material 6. (Page 14, lines 9-11.) When the pieces of material 7 on the first surface 104 have a different size than the pieces of material 6 on the second surface 106, corresponding pieces of material 7, 6 also may be centered with respect to one another. (Id.; page 11, lines 2-9, as amended on June 4, 2003.)

**B. Claims 2-6, 8-10, and 12**

In another exemplary aspect of the invention, as set forth in claim 2, the at least one applicator device may include at least one application station configured to apply pieces of material to objects. Further, the method may include passing the supply strip through the at least one application station to apply the pieces of material from the first and second surfaces. (Page 5, lines 6-9.)

In another exemplary aspect, as set forth in claim 3, the at least one application station includes first and second application stations. The at least one piece of material from the first surface may be applied by passing the supply strip through the first application station and the at least one piece of material from the second surface may be applied by passing the supply strip through the second application station. (Page 5, lines 10-14.) As set forth in claim 4, the supply strip may be passed through the second application station after the supply strip is passed through the first application station. (Page 5, lines 15-16.)

According to another exemplary aspect of the invention, as set forth in claim 5, the at least one applicator device includes first and second sections. When the supply strip is being passed through the first application station, the first surface of the supply

strip may be oriented to face the first section and the second surface may be oriented to face the second section. In this exemplary method, when the supply strip is passed through the second application station, the supply strip may be re-oriented so that the second surface faces the first section and the first surface faces the second section. (Page 6, lines 2-9.) As set forth in claim 6, the re-orienting of the supply strip may include twisting a first part of the supply strip approximately 180 degrees with respect to a second part of the supply strip. (Page 6, lines 9-11.)

In yet another aspect of the invention, as set forth in claim 8, the supply strip may be wound into a roll on a spool after having pieces of material from at least one of the first and second surfaces applied to objects. (Page 6, lines 17-19.) As set forth in claim 9, the supply strip may initially be in the form of a roll on a spool and the supply strip may be fed from the spool. (Page 6, lines 16-17.) An aspect of the invention set forth in claim 10 may further include winding the supply strip into a roll on a second spool after having pieces of material from at least one of the first and second surfaces applied to objects. (Page 6, lines 17-19.)

In another aspect, as set forth in claim 12, when the supply strip is initially in the form of a roll on a first spool, the method may include feeding the roll of supply strip from a first spool to a first application station, passing the supply strip through a second application station, and winding the supply strip onto a second spool after the supply strip is passed through the second application station. (Page 7, lines 9-13.)

**C. Claims 14, 16, and 20**

In still another embodiment, as set forth in claim 14, at least one piece of material from the first surface and at least one piece of material from the second surface may be applied to a group of common objects. (Page 12, lines 11-13.)

In yet another aspect, as set forth in claim 16, the at least one piece of material on the first surface may be different from the at least one piece of material on the second surface. (Page 7, lines 4-8.) In still another aspect, as set forth in claim 20, pieces of material on the first surface may be different from the pieces of material on the second surface and the pieces of material may be applied to a common group of objects.

**D. Claims 21-26, 28-35, and 73**

In some embodiments, as set forth in claim 21, the pieces of material are labels. (Page 8, line 6; page 9, line 14.) As set forth in claim 22, the labels may be self-adhesive. (Id.) As recited in claim 23, the labels may include polyethylene terephthalate. (Page 9, line 15.)

In yet another exemplary aspect, as set forth in claim 24, the labels may have a thickness ranging from about 10 microns to about 40 microns. (Page 9, lines 15-16.) As set forth in claim 25, the labels may have a thickness ranging from about 25 microns to about 36 microns. (Page 9, line 17.)

In some embodiments, as set forth in claim 26, the backing may include material chosen from at least one of paper and thermoplastic, and the first and second surfaces of the backing may be coated with a layer of silicone. (Page 10, lines 3-9.)

In a further exemplary aspect, as set forth in claim 28, the backing may include polyethylene terephthalate. (Page 10, lines 4-5.) In a particular aspect of the invention, as set forth in claim 29, the backing may have a thickness ranging from about 10 microns to about 40 microns. (Page 10, lines 10-11.) Further, in another aspect of the invention, as set forth in claim 30, the backing may have a thickness ranging from about 23 microns to about 36 microns. (Page 10, lines 11-12.)

Another aspect of the invention, as set forth in claim 31, provides that the supply strip may have a thickness ranging from about 60 microns to about 150 microns. (Page 10, lines 17-19.) Further, in another aspect, as set forth in claim 32, the supply strip may have a thickness ranging from about 95 microns to about 140 microns. (Page 10, line 20 – page 11, line 1.)

In still another aspect of the invention, as set forth in claim 33, the pieces of material include a layer of adhesive removably adhering the pieces of material to the first and second surfaces of the backing. The layer of adhesive may have a thickness ranging from about 10 microns to about 20 microns. (Page 10, lines 13-16.)

In some embodiments of the invention, as set forth in claim 34, the objects on which the pieces of material are applied may be bottles. (Page 14, lines 15-16.) As set forth in claim 35, the labels may be substantially transparent. (Page 9, lines 18-19.)

In another aspect, as set forth in claim 73, a first applicator device may be used for applying at least one piece of material from the first surface and a second applicator device may be used for applying at least one piece of material from the second surface. (Page 7, lines 17-19.)

**VI. Grounds of Rejection to be Reviewed on Appeal**

Claims 1-26, 28-35, 72, 73, and 76 stand rejected under 35 U.S.C. § 112, first paragraph.

Claims 1-5, 8-10, 12, 14, 21, 28, 73, and 76 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 2212995 of Schafer, U.S. Patent No. 6,306,475 B1 to Stocq et al., and JP 05-294054 of Iwao.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., Iwao, and U.S. Patent No. 5,143,466 to Moncrieff Baldwin et al. ("Baldwin").

Claims 16, 20, and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., Iwao, and U.S. Patent No. 3,861,986 to Wochner.

Claims 22, 24-26, and 29-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., Iwao, and U.S. Patent No. 6,379,761 to Brandt et al.

Claims 23 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., Iwao, and U.S. Patent No. 5,376,417 to Amano et al.

Claim 28 also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., Iwao, Brandt et al., and U.S. Patent No. 5,569,540 to Hirose et al.

## VII. Argument

### A. **Rejection of claims 1-26, 28-35, 72, 73, and 76 under 35 U.S.C. § 112, first paragraph, should be reversed because the specification provides clear support for the claimed features**

Appellants submit that the original specification provides clear support for the claimed features that the Examiner asserts as lacking support in the written description.

In the final Office Action dated September 22, 2004, the Examiner rejected claims 1-26, 28-35, 72, 73, and 76 under 35 U.S.C. § 112, ¶ 1, asserting, “[n]either the specification as originally filed, or the French document incorporated by reference disclose that the pieces of material on the first surface of the supply strip backing have a different size than the pieces of material on the second surface.” (September 22, 2004, Office Action at 2-3). The Examiner also asserts that “the original specification provides no support for centering the pieces of material on the first and second surface of the supply strip.” Id.

Appellants disagree with the Examiner because the original specification provides clear support for each of the features recited in the claims. For example, with respect to the limitations in claims 1 and 76 relating to pieces having a “different size,” the original specification specifically states that the “invention could be practice[d] with labels having many different configurations,” including “**different size**.” (Page 14, lines 9-11.) (Emphasis supplied.) Also, the specification discloses that pieces of material on the first and second surfaces of the supply strip may be different. (Page 7, lines 6-7.) Even more importantly, the specification discloses an embodiment including labels on the first surface of the backing “positioned substantially opposite to corresponding labels on the second surface” of the backing, and the specification states that such a “configuration is preferable when labels of **different format** are provided on the first and

second surfaces of the backing, **because the backing experiences less weakening from the cutting tool during production.**" (Page 11, lines 2-6.) (Emphasis supplied.)

One of ordinary skill in the art would clearly understand that the above-identified disclosure in the originally-filed specification provides support for the limitations requiring pieces of material on a first surface of a backing to have a "different size" than pieces of material on a second surface of the backing, as recited in claims 1 and 76. For example, one of ordinary skill in the art would understand that the substantially opposite positioned, "different format" labels mentioned at page 11, lines 2-5 would be labels having a different size in order to ensure that "the backing experiences less weakening from [a] cutting tool during production," as described at page 11, lines 5-6. In contrast, if identical-sized labels would be positioned opposite to one another on each side of the backing, a cutting tool forming the labels could likely create mirror-image scoring lines on opposite sides of the backing and thereby cause increased weakening of the backing along those scoring lines.

Different-sized pieces of material that are centered with respect to one another on opposite sides of a backing may enable other possible advantages relating to the manufacture of a supply strip. For example, during manufacturing, the outer edges of the pieces of material on both sides of the supply strip may be cleanly cut, which may possibly reduce or eliminate the spreading of adhesive around the edges of the pieces of material. As a result, when the supply strip is rolled onto itself following the cutting of the pieces of material, the risk of the rolled supply strip being glued together may be reduced.

Thus, without question, the specification supports the “different size” limitations of claims 1 and 76.

Contrary to the Examiner’s apparent assertion in the final Office Action at page 10, the embodiment described in the specification at page 12, lines 11-13, which includes labels having differing labeling information, is not the only example of labels that differ from one another. Indeed, as described above, the specification also discloses examples including labels having different sizes.

In the final Office Action at page 11, the Examiner has clearly mischaracterized disclosure in the specification at page 14. In particular, the disclosure in the specification at page 14, lines 7-11 is not limited to describing examples having different-sized labels only when having a new “processing run.” To the contrary, the disclosure at page 14, lines 7-11 clearly describes having differing label configurations (e.g., different sized labels) on a single supply strip as being an alternative to the exemplary supply strip 4 which may include labels having uniform spacing, shape, and size.

In addition to providing support for the limitations relating to labels having a different size, the original application provides clear support for the recitations in claims 1 and 76 concerning “the pieces of material on the first surface [being] centered with respect to corresponding pieces of material on the second surface.” As explained above, the specification discloses that “the labels on the first surface may be centered with respect to labels on the second surface.” (Page 11, lines 2-4, as amended on June 4, 2003.) Accordingly, the specification clearly supports the centered pieces limitations of claims 1 and 76.



For the reasons explained above, the original disclosure provides clear support for claims 1-26, 28-35, 72, 73, and 76. Accordingly, the rejection of these claims under 35 U.S.C. § 112, ¶ 1, should be reversed.

**B. Rejection of claims 1-5, 8-10, 12, 14, 21, 28, 73, and 76 under 35 U.S.C. § 103(a) should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness**

**1. Factual inquiries related to obviousness**

As explained in Graham v. John Deere Co., 383 U.S. 1, 17 (1966), under 35 U.S.C. § 103(a), an Examiner must first:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate any objective indicia of nonobviousness.

In view of these inquiries, the Examiner must then evaluate whether the claimed invention is obvious. (Id. at 17-18.) When making this evaluation, the references must be considered as a whole and must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. (M.P.E.P. § 2141.) The Examiner may not find obviousness based on multiple references unless the references suggest the desirability, and thus the obviousness of the claimed invention. (Id.) Additionally, there must be a reasonable expectation of success. (Id.) The Examiner bears the initial burden of factually supporting a determination of obviousness. (See M.P.E.P. § 2142.)

Moreover, it is “never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection is based.” (See, e.g., M.P.E.P. § 2144.03.E; In re Zurko, 258 F.3d 1379, 1386,

59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001); In re Ahlert, 424 F.2d 1088, 1092, 165 U.S.P.Q. 418, 421 (C.C.P.A. 1970).) Even if the claimed limitations are within the capabilities of one skilled in the art, such capabilities, by themselves, are not sufficient to establish a *prima facie* case of obviousness. (In re Kotzab, 217 F.3d at 1370, 55 U.S.P.Q.2d at 1318; M.P.E.P. § 2143.01.)

For the reasons explained below, the Examiner's rejection fails to meet the burden of establishing a *prima facie* case of obviousness.

**2. The combination of Schafer, Iwao, and Stocq et al. fails to establish a *prima facie* case of obviousness**

The cited references do not teach or suggest all the elements recited in claims 1-5, 8-10, 12, 14, 21, 28, 73, and 76.

**a. Disclosure of Schafer, Iwao, and Stocq et al.**

Schafer discloses a label strip with labels on both sides, wherein the labels on opposing sides are staggered with respect to one another. (See, e.g., Figs. 1-4.) According to Schafer, "[t]o be able to also process strips in which the labels on the two sides of backing strip 3 have different spacings [i.e., staggered], a feed device 60 is also connected downstream from holder 52." (Schafer translation at 11.) Thus, Schafer discloses a device specifically configured to dispense labels from a label strip having the staggered configuration shown in Figs. 1-4, without having any disclosure of pieces of material being centered. Schafer also does not disclose having the backing of the strip formed of substantially the same material as the labels.

Iwao discloses a label strip with labels adhered to both sides of a backing, wherein the labels on both sides have the same size and are positioned directly

opposed from one another so that edges of opposing labels line up exactly. (See Figs. 1, 3, and 4.) Iwao does not disclose a backing strip formed of substantially the same material as the labels.

Stocq et al. discloses a “pressure-sensitive laminate and a method of making the same, for which the release strength between an adhesive layer and a release liner can be selectively varied after the laminate has been manufactured by exposing the interface between the adhesive layer and the release liner to ultraviolet light.” (Stocq et al., Abstract.) Stocq et al. incidentally discloses that a backing sheet could be selected from “clear polymeric films, such as those used for the face sheet” of the laminate (Stocq et al., col. 3, lines 52-54), but does not teach or suggest any reason why one would make such a selection.

**b. Schafer, Iwao, and Stocq et al. do not teach or suggest the claimed subject matter**

Each of independent claims 1 and 76 recites, inter alia, “the pieces of material on the first surface” of the supply strip backing have “a **different size** than the pieces of material on the second surface,” and “the pieces of material on the first surface are **centered** with respect to corresponding pieces of material on the second surface” (emphasis added). None of the cited references, alone or in combination, teaches or suggests these features of the claimed invention.

While the Examiner acknowledged that Schafer, the primary reference relied upon, does not teach or suggest pieces of material on a first surface of a backing centered with respect to differently-sized pieces of material on a second surface of the backing, the Examiner contends that in view of Iwao, one of ordinary skill in the art would have modified Schafer to abandon its staggered label configuration in favor of a

hypothetical label strip having differently-sized labels on opposing sides of the backing centered with respect to one another. (September 22, 2004, Office Action at 4-5.)

Appellants respectfully disagree because neither Schafer, Iwao, nor any combination thereof teaches or suggests a supply strip, wherein “the pieces of material on the first surface have a different size than the pieces of material on the second surface,” and wherein “the pieces of material on the first surface are centered with respect to corresponding pieces of material on the second surface,” as recited in claims 1 and 76.

As explained above, Schafer teaches a double-sided label strip with a staggered configuration and a specially-designed feed device to process a strip with this staggered configuration. Schafer fails to disclose or even suggest that material pieces on first and second surface of a supply strip may be centered relative to each other. In fact, Schafer’s staggered label configuration teaches away from having centered pieces of material.

Iwao does not provide any suggestion or motivation to modify Schafer to abandon Shaefer’s staggered configuration or to use a centered configuration with material pieces of different sizes. The Examiner asserts that Iwao “discloses centering the pieces of material on the first and second surface of the supply strip relative to each other.” (September 22, 2004, Office Action at 4.) Appellants disagree. Although the drawings accompanying Iwao depict lining up edges of opposing labels having the same size, Iwao does not generally disclose the concept of centering labels or otherwise provide any reason why one would do so. Contrary to the Examiner’s assertion in the final Office Action at pages 3-4, neither Iwao nor any of the other cited references has any disclosure supporting the Examiner’s assertion that “[o]ne in the art

would immediately appreciate that [centering pieces of material] can improve handling of the web.” Such an assertion is completely unsupported by the cited references, which indicates that the Examiner has improperly relied upon hindsight.

Moreover, the Examiner fails to cite to any teachings in Iwao that would provide any suggestion or motivation to use material pieces of different sizes on opposing sides of a supply strip. If anything, Iwao suggests using labels of exactly the same size on both sides of the backing.

Stocq et al. fails to disclose or suggest either the centered material pieces limitation or the different-sized limitation of claims 1 and 76. Accordingly, even if Stocq et al. could be combined with the other cited references, there would be no suggestion of either the method of claim 1 or the method of claim 76.

For at least the above reasons, Appellants respectfully request reversal of the rejection of claims 1 and 76 under 35 U.S.C. § 103(a). In addition, given that 5, 8-10, 12, 14, 21, 28, and 73 depend from claim 1, the Section 103(a) rejection of those claims should be withdrawn for the same reasons.

Claim 1 also recites, “the backing and the pieces of material being formed of substantially the same material . . . .” With respect to this feature, the Examiner asserts that “[o]ne in the art would appreciate Schafer, which is silent as to the materials used, is intended to be used with any conventional and known piece and backing system, including one wherein the materials are the same, as shown in Stocq et al.”

(September 22, 2004, Office Action at 4.) The Examiner further asserts that “the level of ordinary skill at the time of the invention, as represented by Stocq et al., explicitly discloses that among the materials known for the backing sheet include ‘those used for

the face sheet' (column 3, lines 53-54)." (September 22, 2004, Office Action at 12.)

The Examiner also alleges that "such a selection would be available as a design choice" for label material as well. (Id.)

Appellants respectfully submit that the Examiner improperly attempts to shift the burden of proving nonobviousness to the Appellants, rather than presenting a *prima facie* case of obviousness by citing one or more references that would teach or suggest the claimed invention. Specifically, the Examiner fails to cite to any teaching in Stocq et al. or any other reference that would have provided any sufficient suggestion or motivation to use substantially the same material for pieces of material and a backing. An "obvious to try" suggestion does not render a claim obvious. In re Roemer, 258 F.3d 1303, 1310 (Fed. Cir. 2001). The Examiner's implicit assertion that anything allegedly known to one of skill in the art would be obvious is nonsensical. Furthermore, nothing at all supports the Examiner's design choice allegation concerning selection of materials.

Rather than providing any disclosure or suggestion of substantially the same material being used for **pieces of material and a backing**, Stocq et al. merely discloses that the front face and backing of a supply strip may be made of the same material. Stocq et al. fails to suggest that pieces of material (e.g., labels) may be made of substantially the same material as the backing. Since none of the cited references has any disclosure or suggestion of pieces of material being formed of substantially the same material as a backing, the Examiner's obviousness rejection is completely unsupported.

Thus, contrary to the Examiner's assertion, the cited references do not teach or suggest all of the features of claim 1. For this additional reason, Appellants respectfully request reversal of the rejection of claims 1-5, 8-10, 12, 14, 21, 28, and 73 under 35 U.S.C. § 103(a).

Dependent claim 5 further recites, "the first surface of the supply strip being oriented to face [a] first section and the second surface being oriented to face [a] second section when the supply strip is passed through [a] first application station." The method further recites "re-orienting the supply strip so that the second surface faces the first section and the first surface faces the second section when the supply strip is being passed through [a] second application station." Schafer and the other cited references fail to disclose or suggest a method in which the supply strip is re-oriented as recited in claim 5. Accordingly, for this additional reason, Appellants respectfully request reversal of the rejection of claim 5 under 35 U.S.C. § 103(a).

Claim 28 further recites that "the backing includes polyethylene terephthalate." None of the cited references discloses or suggests such material. Stocq et al. discloses that the backing can be made using clear polyethylene, but there is no disclosure or suggestion of polyethylene terephthalate. Accordingly, for this additional reason, Appellants respectfully request reversal of the rejection of claim 28 under 35 U.S.C. § 103(a).

**C. Rejection of claim 6 under 35 U.S.C. § 103(a) should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness**

The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., Iwao, and Baldwin. Claim 6 depends from claim 1, and

therefore, should be allowable for at least the same reasons as claim 1. Further, Baldwin fails to cure the deficiencies of Schafer, Stocq et al., and Iwao, discussed above with respect to claim 1. Therefore, regarding claim 6, Appellants maintain that the Examiner has not established a *prima facie* case of obviousness. Accordingly, Appellants respectfully request reversal of the rejection of claim 6 under 35 U.S.C. § 103(a).

**D. Rejection of claims 16, 20, and 34 under 35 U.S.C. § 103(a) should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness**

The Examiner rejected claims 16, 20, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., Iwao, and Wochner. Claims 16, 20, and 34 depend from claim 1, and therefore, should be allowable for at least the same reasons as claim 1. Further, Wochner fails to cure the deficiencies of Schafer, Stocq et al., and Iwao, discussed above with respect to claim 1. Claims 16 and 20 recite methods in which pieces of material on the first surface differ from the pieces of material on the second surface. Rather than having disclosure of different material pieces on different surfaces of a backing, Wochner discloses having different labels on only a single side of a backing. Nothing in Wochner provides any disclosure or suggestion of pieces of material on a first surface that differ from the pieces of material on a second surface. Therefore, regarding claims 16, 20, and 34, Appellants maintain that the Examiner has not established a *prima facie* case of obviousness. Accordingly, Appellants respectfully request reversal of the rejection of claims 16, 20, and 34 under 35 U.S.C. § 103(a).



**E. Rejection of claims 22, 24-26, and 29-34 under 35 U.S.C. § 103(a) should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness**

The Examiner rejected claims 22, 24-26, and 29-34 under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., Iwao, and Brandt et al. Claims 22, 24-26, and 29-34 depend from claim 1, and therefore, should be allowable for at least the same reasons as claim 1. Further, Brandt et al. fails to cure the deficiencies of Schafer, Stocq et al., and Iwao, discussed above with respect to claim 1. Therefore, regarding claims 22, 24-26, and 29-34, Appellants maintain that the Examiner has not established a *prima facie* case of obviousness. Accordingly, for the above reasons, Appellants respectfully request reversal of the rejection of claims 22, 24-26, and 29-34 under 35 U.S.C. § 103(a).

**F. Rejection of claims 23 and 35 under 35 U.S.C. § 103(a) should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness**

The Examiner rejected claims 23 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., Iwao, and Amano et al. Claims 23 and 35 depend from claim 1, and therefore, should be allowable for at least the same reasons as claim 1. Further, Amano et al. fails to cure the deficiencies of Schafer, Stocq et al., and Iwao, discussed above with respect to claim 1. Therefore, regarding claims 23 and 35, Appellants maintain that the Examiner has not established a *prima facie* case of obviousness. Accordingly, Appellants respectfully request reversal of the rejection of claims 23 and 35 under 35 U.S.C. § 103(a).

**G. Rejection of claim 28 under 35 U.S.C. § 103(a) should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness**

The Examiner rejected claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Schafer, Stocq et al., Iwao, Brandt et al., and Hirose et al. Claim 28 depends from claim 1, and therefore, should be allowable for at least the same reasons as claim 1. Further, Brandt et al. and Hirose et al. fail to cure the deficiencies of Schafer, Stocq et al., and Iwao, discussed above with respect to claim 1. Claim 28, which depends from claim 1, further recites that “the backing includes polyethylene terephthalate” [PET]. The Examiner admits that Brandt et al. “is silent [as] to [the use of] PET” as a backing. (September 22, 2004, Office Action at 10.) The Examiner, however, cites Hirose et al., which describes an example having a PET “substrate film.” (*Id.*) Hirose et al. discloses a thermal transfer sheet and provides no suggestion that its disclosed thermal transfer sheet could be used in conjunction with an applicator device, supply strip, and backing. Therefore, regarding claim 28, Appellants maintain that the Examiner has not established a *prima facie* case of obviousness. Accordingly, Appellants respectfully request reversal of the rejection of claim 28 under 35 U.S.C. § 103(a).

**H. Conclusion**

For the reasons given above, claims 1-6, 8-10, 12, 14, 16, 20-26, 28-35, 73, and 76 are patentable over the cited references. The Board is therefore respectfully requested to reverse the outstanding rejections under 35 U.S.C. §§ 112, first paragraph, and 103(a), so that claims 1-6, 8-10, 12, 14, 16, 20-26, 28-35, 73, and 76 may be allowed.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due which are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: February 22, 2005

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VIII. Claims Appendix

1. A method of applying pieces of material to objects, the method

comprising:

providing a material supply strip and at least one applicator device capable of applying material from said supply strip to objects, said supply strip initially including a backing having first and second opposing surfaces and pieces of material removably arranged on both of the first and second surfaces, the backing and the pieces of material being formed of substantially the same material, wherein the pieces of material on the first surface have a different size than the pieces of material on the second surface, and wherein the pieces of material on the first surface are centered with respect to corresponding pieces of material on the second surface;

applying at least one piece of material from the first surface of the backing to at least one object with said at least one applicator device; and

applying at least one piece of material from the second surface of the backing to at least one object with said at least one applicator device.

2. The method of claim 1, wherein said at least one applicator device includes at least one application station configured to apply pieces of material to objects, and wherein the applying of said at least one piece of material from the first surface and the applying of said at least one piece of material from the second surface includes passing the supply strip through said at least one application station.

3. The method of claim 2, wherein said at least one application station includes first and second application stations, and wherein the applying of said at least

one piece of material from the first surface includes passing the supply strip through the first application station, and the applying of said at least one piece of material from the second surface includes passing the supply strip through the second application station.

4. The method of claim 3, wherein the supply strip is passed through the second application station after the supply strip is passed through the first application station.

5. The method of claim 4, wherein said at least one applicator device includes first and second sections, the first surface of the supply strip being oriented to face the first section and the second surface being oriented to face the second section when the supply strip is being passed through the first application station, and wherein the method further comprises re-orienting the supply strip so that the second surface faces the first section and the first surface faces the second section when the supply strip is being passed through the second application station.

6. The method of claim 5, wherein the re-orienting of the supply strip includes twisting a first part of the supply strip approximately 180 degrees with respect to a second part of the supply strip.

8. The method of claim 1, further comprising winding the supply strip into a roll on a spool after at least one of the applying of said at least one piece of material from the first surface and the applying of said at least one piece of material from the

second surface.

9. The method of claim 1, wherein the supply strip is initially in the form of a roll on a spool, and wherein the method further comprises feeding the supply strip from the spool.

10. The method of claim 9, wherein the method further comprises winding the supply strip into a roll on a second spool after at least one of the applying of said at least one piece of material from the first surface and the applying of said at least one piece of material from the second surface.

12. The method of claim 4, wherein the supply strip is initially in the form of a roll on a first spool, and wherein the method further comprises:

feeding the roll of supply strip from the first spool to the first application station;  
and

winding the supply strip into a roll on a second spool after the supply strip is passed through the second application station.

14. The method of claim 1, wherein at least one piece of material from the first surface and at least one piece of material from the second surface are applied to a group of common objects.

16. The method of claim 1, wherein at least one piece of material on the first

surface is different from at least one piece of material on the second surface.

20. The method of claim 14, wherein the pieces of material on the first surface are different from the pieces of material on the second surface.

21. The method of claim 1, wherein the pieces of material are labels.

22. The method of claim 21, wherein the labels are self-adhesive.

23. The method of claim 21, wherein the labels include polyethylene terephthalate.

24. The method of claim 21, wherein the labels have a thickness ranging from about 10 microns to about 40 microns.

25. The method of claim 24, wherein the labels have a thickness ranging from about 25 microns to about 36 microns.

26. The method of claim 1, wherein the backing includes material chosen from at least one of paper and thermoplastic, and wherein the first and second surfaces of the backing are coated with a layer of silicone.

28. The method of claim 1, wherein the backing includes polyethylene

terephthalate.

29. The method of claim 1, wherein the backing has a thickness ranging from about 10 microns to about 40 microns.

30. The method of claim 29, wherein the backing has a thickness ranging from about 23 microns to about 36 microns.

31. The method of claim 1, wherein the supply strip has a thickness ranging from about 60 microns to about 150 microns.

32. The method of claim 31, wherein the supply strip has a thickness ranging from about 95 microns to about 140 microns.

33. The method of claim 1, wherein the pieces of material include a layer of adhesive removably adhering the pieces of material to the first and second surfaces of the backing, said layer of adhesive having a thickness ranging from about 10 microns to about 20 microns.

34. The method of claim 1, wherein the objects are bottles.

35. The method of claim 21, wherein the labels are substantially transparent.



73. The method of claim 1, wherein a first applicator device is used for the applying of the at least one piece of material from the first surface and a second applicator device is used for the applying of the at least one piece of material from the second surface.

76. A method of applying pieces of material to objects, the method comprising:

providing a material supply strip and at least one applicator device capable of applying material from said supply strip to objects, said supply strip initially including a backing having first and second opposing surfaces and pieces of material removably arranged on both of the first and second surfaces, the pieces of material on the first surface having a different size than the pieces of material on the second surface, wherein the pieces of material on the first surface are centered with respect to corresponding pieces of material on the second surface;

applying at least one piece of material from the first surface of the backing to at least one object with said at least one applicator device; and

applying at least one piece of material from the second surface of the backing to at least one object with said at least one applicator device.

**IX. Evidence Appendix**

None

X. **Related Proceedings Appendix**

None